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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,526	09/17/2003	Robert J. Apel	DOM1091-203	4289

8698 7590 05/24/2005  
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EXAMINER

GARRETT, ERIKA P

ART UNIT PAPER NUMBER

3636

DATE MAILED: 05/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/664,526

Applicant(s)

APEL, ROBERT J.

Examiner

Erika Garrett

Art Unit

3636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The applicant states that the "building codes does not allow crossing a property line with a building that will be separately titled from a building on the adjacent property lot". If this is true, how can the applicant claim this?

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7 and 9-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Jenn (4,685,260). Jenn discloses the use of residential housing unit (20) comprising two independent living units (21-24), common space (63,62) wherein the common

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space connects the two independent living units, wherein the common space is divided between the two property lots, see figure 1. In regards to claim 2, wherein the two independent living units are different sizes. In regards to claims 3&11, wherein the common space further comprises a center wall, see figure 1-3. In regards to claims 4&10, wherein the common space is a private room. In regards to claim 5, the living units are deeded to two owners. In regards to claim 6, further comprising two garages (25,26) each garage is attached to each independent living unit, see figure 2. In regards to claim 7, wherein the two independent living units each contain a frontal access door, figure 1. In regards to claim 9, a housing unit comprising two structures for the purpose of providing a habitation by humans, wherein each of the two structures is connected to the other structure by a common space, wherein the two structures are positioned on two property lots, the structures each containing a frontal access door, and the common space of the two structures is divided between the two property lots. In regards to claim 12, the housing unit is built with the common space equally divided across a property line that divides the two property lots.

Claims 1-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Taylor (4,575,977). Taylor discloses the use of residential housing unit comprising two independent living units (22 and 24), common space (grass between the lots) wherein the common space connects the two independent living units, wherein the common space is divided between the two property lots, see figure 1. In regards to claim 2, wherein the two independent living units are of different sizes. In regards to claims 3&11, wherein the common space further comprises a center wall (52). In regards to

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claims 4&10, wherein the common space is selected from the group consisting of a Florida room with screen or windows, a porch, a hallway, a **breezeway**, a private or shared activity room, a private or shared laundry room, a dining room, and an exercise room. In regards to claim 5, the living units are deeded to two owners. In regards to claim 6, further comprising two garages (46) each garage is attached to each independent living unit, see figure 1. In regards to claim 7, wherein the two independent living units each contain a frontal access door (58) figure 1. In regards to claim 8, the frontal access faces the same direction. In regards to claim 9, a housing unit comprising two structures for the purpose of providing a habitation by humans, wherein each of the two structures is connected to the other structure by a common space, wherein the two structures are positioned on two property lots, the structures each containing a frontal access door, and the common space of the two structures is divided between the two property lots. In regards to claim 12, the housing unit is built with the common space equally divided across a property line (56) that divides the two property lots.

Claims 1-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Finnegan (4,007,565). Finnegan discloses the use of residential housing unit (100) comprising two independent living units (106,110), common space (grass between property lots) wherein the common space connects the two independent living units, wherein the common space is divided between the two property lots, see figures 1-4. In regards to claim 2, wherein the two independent living units are different sizes. In regards to claims 3&11, wherein the common space further comprises a center wall,

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see figure 1-3. In regards to claims 4&10, wherein the common space is selected from the group consisting of a Florida room with screen or windows, a porch, a hallway, a **breezeway**, a private or shared activity room, a private or shared laundry room, a dining room, and an exercise room. In regards to claim 5, the living units are deeded to two owners. In regards to claim 6, further comprising two garages (102,104) each garage is attached to each independent living unit, see figure 2. In regards to claim 7, wherein the two independent living units each contain a frontal access door, figure 1. In regards to claim 8, the frontal access faces the same direction. In regards to claim 9, a housing unit comprising two structures for the purpose of providing a habitation by humans, wherein each of the two structures is connected to the other structure by a common space, wherein the two structures are positioned on two property lots, the structures each containing a frontal access door, and the common space of the two structures is divided between the two property lots. In regards to claim 12, the housing unit is built with the common space equally divided across a property line that divides the two property lots.

Claims 1-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Raynor (5,469,673). Raynor discloses the use of residential housing unit (10) comprising two independent living units (44,46), common space (84) wherein the common space connects the two independent living units, wherein the common space is divided between the two property lots, see figures 1-4. In regards to claim 2, wherein the two independent living units are different sizes. In regards to claims 3&11, wherein the common space further comprises a center wall (82). In regards to claims 4&10, wherein

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the common space is selected from the group consisting of a Florida room with screen or windows, a porch, a hallway, a **breezeway**, a private or shared activity room, a private or shared laundry room, a dining room, and an exercise room. In regards to claim 5, the living units are deeded to two owners. In regards to claim 6, further comprising two garages (70) each garage is attached to each independent living unit, see figure 2. In regards to claim 7, wherein the two independent living units each contain a frontal access door (72). In regards to claim 8, the frontal access faces the same direction. In regards to claim 9, a housing unit comprising two structures for the purpose of providing a habitation by humans, wherein each of the two structures is connected to the other structure by a common space, wherein the two structures are positioned on two property lots, the structures each containing a frontal access door, and the common space of the two structures is divided between the two property lots. In regards to claim 12, the housing unit is built with the common space equally divided across a property line that divides the two property lots.

### ***Response to Arguments***

Applicant's arguments filed 2/28/05 have been fully considered but they are not persuasive.

Applicant's arguments with respect to claim 1-12 have been considered but are moot in view of the new ground(s) of rejection.

In response to applicant's argument that *living units are positioned on two property lots*, a recitation of the intended use of the claimed invention must result in a

**structural difference** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The examiner is of the opinion that the living units can be positioned on two property lots, since the owner can divide the property the way they want it. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

In the applicants argument that *"current codes doesn't permit the building of a structure across a property lines (or even within so many feet of the property line)"* and *Jenn does not disclose*. The applicant is reminded that this not a patent issue. This is does not constitute the structure of the patent. Therefor, The examiner is of the opinion that Jenn does disclose a common space across property lots.

In response to applicant's statement that *two independent living units are deeded to two owners*, a recitation of the intended use of the claimed invention must result in a **structural difference** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The examiner is of the opinion that the independent living units can be deeded to two owners, since you can divide the property the way you want it. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).




**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erika Garrett whose telephone number is 571-272-6859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EG  
May 17, 2005

  
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